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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,915	12/05/2001	James A. Campo	ARW 2 0174	8504

7590 05/14/2004

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EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

10

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,915

Applicant(s)

CAMPO ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This is a response to the Amendment received on February 20, 2004, in which claims 1-3, 6-7, 12-14, 19, 22-24. Claims 1-31 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 20, 2004 has been entered.

Election/Restrictions

Claims 20-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 3.

This application contains claims 20-21 drawn to an invention nonelected without traverse in Paper No. 3.. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01..

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not clear on the how or why the processor includes a unique identifier wherein the unique identifier is an IP address. The specification is not clear if the IP address is located in the processor's memory, in a network card's memory or some other various components on the processor module. The Examiner is treating the claim with respect to the specification. Please refer to the "Response to Arguments" below for additional comments that are incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-18 and 22-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Bealkowski et al. (U.S. Patent No. 5,355,489; hereafter "Bealkowski") in view of Wiltshire et al. (U.S. Patent No. 6,409,602; hereafter "Wiltshire").

Bealkowski discloses a computer having a main processor for operation of a program, the computer having at least one I/O device; and a processor module removably connected to the computer, the processor module including a main processor for controlling the operation of the computer and running the program (abstract). A computer, without a main processor, is viewed

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to be a dumb machine and the main processor can be added or switched to any like computer and have the same functionality. Bealkowski does not disclose a computer being used for playing games. However, Wiltshire discloses a computer that has game capabilities (abstract). One would be motivated to combine the references in order to allow users to be entertained by the play of games on the computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the game features of Wiltshire into the computer of Bealkowski in order to allow a user to play games on the computer.

Referring to claim 3, Bealkowski discloses the personal computer having a housing having a bay for receiving the processor module and the bay includes a connector for connecting the processor module to the electronic gaming unit.

Referring to claims 4-5, Bealkowski discloses that a processor module includes a unique identifier where the identifier is an ID address. It is conventional within the art of computers that a processor has a personal identification address.

Referring to claims 6-7, Bealkowski in view of Wiltshire disclose a plug-in communication module electrically connected to the main processor for communicating with another gaming unit in a logical network (Figure 1D), wherein the other gaming unit is a master computer in a logical network.

Referring to claims 8-9, Bealkowski in view of Wiltshire disclose the plug-in communication module includes wireless communication hardware (abstract), wherein the wireless communication hardware includes security means (7:15-18).

Referring to claims 10-11, Bealkowski in view of Wiltshire disclose the plug-in communication module includes hard-wired communication hardware (Figure 1D, item 130),

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wherein the hard-wired communication hardware includes at least one of Ethernet hardware and a telephone line.

Claims 12-18 correspond in scope to a electronic gaming system set forth for use of the electronic gaming system listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 22-28 correspond in scope to a electronic gaming system set forth for use of the electronic gaming system listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 1-19 and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (U.S. Pub No 2002/0022499; hereafter "Newman") in view of Wiltshire.

Newman discloses a dumb remote electronic gaming unit for use by a player during a program, the dumb remote electronic unit comprising an output device and a connector (Figure 4, item 3 and item 10 on item 3 connects to the core computer), a processor removably connected to the dumb electronic unit via the connector, the processor module including a processor for controlling the operation of the dumb electronic unit and running a program during use of the dumb electronic unit (abstract) and a plug-in communication module removably connected to the dumb remote unit, the communication module including communication hardware for providing a communication link between the dumb remote unit and another unit in the network, but does not disclose the ability to play games on the personal communicator. However, Wiltshire discloses a mobile computer that has game capabilities (abstract). One would be motivated to combine the references in order to allow users to be entertained by the play of games on the

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computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the game features of Wiltshire into the computer of Newman in order to allow a user to play games on the computer.

Referring to claims 13-14, Newman in view of Wiltshire disclose a plug-in communication module electrically connected to the main processor for communicating with another gaming unit in a logical network (Figure 1D), wherein the another gaming unit is a master computer in a logical network.

Referring to claims 15, Newman in view of Wiltshire disclose the plug-in communication module includes wireless communication hardware (abstract), wherein the wireless communication hardware includes security means.

Referring to claims 16, Newman in view of Wiltshire disclose the output device comprises a display.

Referring to claims 17-18, Newman in view of Wiltshire disclose the plug-in communication module includes hard-wired communication hardware (Figure 1D, item 130), wherein the hard-wired communication hardware includes at least one of Ethernet hardware and a telephone line.

Referring to claim 19, Newman in view of Wiltshire disclose the dumb remote gaming unit includes a housing in which the output device and the connector are disposed and further comprising an external connector, wherein the communication module is a plug-in module for connecting to the connector.

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Claims 1-11 correspond in scope to a electronic gaming system set forth for use of the electronic gaming system listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 22-28 correspond in scope to a electronic gaming system set forth for use of the electronic gaming system listed in the claims above and are encompassed by use as set forth in the rejection above.

Referring to claim 29, Newman in view of Wiltshire disclose an electronic gaming system, but do not specifically disclose having a theft deterrent feature on the device. However, it is notoriously well known with the art of mobile computers that passwords can be implemented on the computer in order to deter others from stealing a phone. One would be motivated to add this feature onto the device of Newman in view of Wiltshire in order to deter others from stealing a phone and to limit the access to the user's privacy. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate password protection to the phone into the system of Newman and Wiltshire in order to deter others from stealing a phone and to limit others access to the user's privacy.

Referring to claims 30-31, Newman in view of Wiltshire disclose a battery connected to the housing for powering the I/O device (page 2, paragraph 17; page 4, paragraphs 39-40), but does not specifically disclose having battery backups in the processor module. However, it is notoriously well known within the art of PDAs to have a battery backup in order to retain memory when using memory modules to prevent data loss when a power failure occurs. One would be motivated to add this feature onto the device of Newman in view of Wiltshire in order to retain memory when using memory modules to prevent data loss when a power failure occurs.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a battery backup into the device of Newman and Wiltshire in order to retain memory when using memory modules to prevent data loss when a power failure occurs.

Response to Arguments

Applicant's arguments filed February 20, 2004 have been fully considered but they are not persuasive.

Applicant argues that claim 5 meets the enablement requirement. However, the specification is not clear on the how or why the processor includes a unique identifier wherein the unique identifier is an IP address. The specification is not clear if the IP address is located in the processor's memory, in a network card's memory or some other various components on the processor module. The Examiner is concerned with the claim since IP addresses are generally not associated with a fixed piece of hardware and an IP address is associated with a component only after the machine is connected to the network. The specification fails the test of enablement since one of ordinary skill in the art cannot use the invention from the disclosure without undue experimentation. Therefore, Applicant's arguments fail to overcome the 112, 1st paragraph rejection.

Applicant argues that the combination of Bealkowski in view of Wiltshire fail to disclose a dumb remote electronic gaming unit running a game play program during game play. However, Bealkowski in view of Wiltshire disclose an electronic gaming system comprising a dumb remote electronic gaming units within a computer network wherein a dumb remote electronic gaming unit running a game play program during game play (abstract, with respect to

the displaying of output and wagering input, 2:39-44). The Examiner views the client/terminal program that displays the information to the player as game play program since the player cannot proceed playing the game without the information from the display. Further, Wiltshire discloses that upgrades and modifications to hardware and software are greatly reduced at the dumb terminals not that upgrades and modifications are eliminated completely at each of the dumb terminals (2:45-51). Even so, the Applicant statement is grossly misrepresenting the art of a computer network. Therefore, the claimed invention fails to preclude the invention of Bealkowski and Wiltshire.

Applicant argues that Newman and Wiltshire fail to disclose a dumb handheld unit having a remote processor. However, as stated above, Newman in combination with Wiltshire disclose a dumb remote computer (Figure 4, items 2 and 3) having a remote processor (Figure 4, item 4). Therefore, the claimed invention fails to preclude the invention of Newman and Wiltshire.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc


JESSICA HARRISON
PRIMARY EXAMINER